

Interview Summary

Application No.

09/813,688

Applicant(s)

WEST ET AL.

Examiner

Tan Dean D. Nguyen

Art Unit

3629

All participants (applicant, applicant's representative, PTO personnel):

(1) Tan Dean D. Nguyen.

(3)_____.

(2) Chris Tanner.

(4)_____.

Date of Interview: 10 March 2004.

Type: a) ☒ Telephonic b) ☐ Video Conference
c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.
If Yes, brief description: _____.

Claim(s) discussed: 1-26.

Identification of prior art discussed: Prior Art of Record.

Agreement with respect to the claims f) ☐ was reached. g) ☒ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: see paper No. 5.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

Examiner's signature, if required

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

09/813,688

#5

3/10/04

Nguyen, Dean

EX'S #5 INTERVIEW

From: cmtanner@stockwell-law.com
Sent: Wednesday, March 10, 2004 10:51 AM
To: Nguyen, Dean
Subject: Re: 09/813,688, received just fine, thanks for your consideration, other thoughts

Dean I received your response and appreciate your promptness. No need to call back, although a response to the below would be appreciated.

In response to your remarks below, we are not claiming a "general love theme", instead we claim a "love story theme". To that end, one of your key most-cited references, Love, mentions birthday and anniversary. These are indeed "general love themes", but they are not "love story themes", and definitely aren't "FABLED love story theme AS EXCERPTED FROM POPULAR ROMANTIC LITERATURE".

We both know you are not required to find the exact elements in order to reject. However, if it were obvious to include defined, FABLED love story theme AS EXCERPTED FROM POPULAR ROMANTIC LITERATURE, why is nobody doing this? In all your lengthy and complex searching, you were unable to find this. None of your prior art asserted so far contains this element, nor suggests it. To that end, would an Affidavit of Commercial Success assist you in making a decision?

Finally, because of the amount of effort required to market and correlate jewelry with specific excerpts from popular romantic literature, I think such an endeavor would fall outside the scope of "routine experimentation", no? There are many jewelry exhibits, and many jewelry patents, in existence. Thus, jewelry displays are a crowded, well-known area in which tons of references are available. However, none of them mention or even suggest marketing of jewelry with specific excerpts from popular romantic literature. Accordingly, the amount of "experimentation" required to arrive at such a mechanism would be assuming a level of prescience perhaps on the level of clairvoyance, and thus far exceeding the standard of "routine" which you so ably note. If it were routine experimentation, you should be able to find it, even considering the limited amount of time allotted to you for searching. In other words, such an inductive marketing leap would be far beyond one of ordinary skill in the art, and could only be arrived at using impermissible hindsight.

Mr. Nguyen thanks again for your cooperation. Regardless of the outcome, you have been both prompt and skillful in your management of this application.

chris tanner, esq.

----- Original Message -----

From: Nguyen, Dean
To: cmtanner@stockwell-law.com
Sent: Wednesday, March 10, 2004 10:07 AM
Subject: RE: 09/813,688, attorney Chris making suggested claim amendment

3/10/04

Hi Chris,

I don't plan to return your call since I have sent you an Email response earlier. Please verify so I don't have to call you as required by the PTO. Thanks.

probably NO since the use of various type and/or degree of love from the general "love theme" would have been obvious to a skilled artisan as routine experimentations to suit the desired application. The source/origination of the "theme" carries little patentable weight and would have been obvious to use other well known love story themes.

Best Regards,
 Dean Nguyen.

3/10/04

-----Original Message-----

From: cmtanner@stockwell-law.com [mailto:cmtanner@stockwell-law.com]
Sent: Monday, March 08, 2004 6:08 PM
To: Nguyen, Dean
Subject: Re: 09/813,688, attorney Chris making suggested claim amendment

Dean please think about this suggestion for 09/813,688. Suppose I amended all claims as follows:

Everywhere the expression "defined love story theme" appears, I replace with the expression "defined, FABLED love story theme AS EXCERPTED FROM POPULAR ROMANTIC LITERATURE". Support for such a proposed amendment appears at least on page 7, line 14; page 8 line 6, and the end of page 7 to the beginning of page 8.

None of the prior art references suggest such a feature. In your rejection, you state that the "Love" reference (USPN: 4,043,449) mentions "anniversary or birthday" and use that to reject the claimed "defined love story theme". Dean, can I get you to consider that the above clarifying amendment would overcome this rejection?

thanks for your consideration, please respond with your thoughts
 ct

Chris Tanner, Associate
cmtanner@stockwell-law.com

STOCKWELL & ASSOCIATES, PSC
 861 Corporate Drive, Suite 201
 Lexington, Kentucky 40503
 Telephone: (859) 223-3400
 Facsimile: (859) 224-1399
mail@stockwell-law.com
<http://www.stockwell-law.com>

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----- Original Message -----

From: Nguyen, Dean
To: cmtanner@stockwell-law.com
Sent: Tuesday, March 02, 2004 1:10 PM
Subject: 09/813,688

Hi Chris,

I have thoroughly reviewed this case again and I don't think there is any allowable subject in the indep and dep claims. The rejections are strong.

Best Regard to you and the inventors.

Exmnr Dean Nguyen

(703)308-2053.

-----Original Message-----

From: cmtanner@stockwell-law.com [mailto:cmtanner@stockwell-law.com]
Sent: Monday, March 01, 2004 9:08 AM
To: Nguyen, Dean
Subject: Fw: test of e-address

Chris Tanner, Associate
cmtanner@stockwell-law.com

STOCKWELL & ASSOCIATES, PSC
861 Corporate Drive, Suite 201
Lexington, Kentucky 40503
Telephone: (859) 223-3400
Facsimile: (859) 224-1399
mail@stockwell-law.com
<http://www.stockwell-law.com>

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Nguyen, Dean

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Chris Tanner, Associate
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Subject: Fw: test of e-address

3/10/04